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EXAMINER

MARIAM, DANIEL G

ART UNIT PAPER NUMBER

2621

DATE MAILED: 05/18/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,756

Applicant(s)

BLACK, GERALD R.

Examiner

DANIEL G MARIAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 3,6,9,12 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claims 3, 9, and 15 are objected to because of the following informalities: claims 3, 9, and 15 do not end with a period. Each claim begins with a capital letter and ends with a period (See MPEP 608.01(m)). Appropriate correction is required.
2. Claims 6, 12, and 18 are objected to because they contain a duplicate limitation (i.e., text written on the surface). Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. Following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Karamchetty (6,728,881).

With regard to claim 1, Karamchetty discloses an identity authentication device having the general shape of a (stylus) (See for example, Figure 5), the device comprising: a processor disposed within the (stylus) (item 380, in Fig. 5), the processor having memory (item 390, in Fig. 5), the (stylus including a component for capturing within the processor memory a written signature generated by the stylus while the stylus is writing upon a surface) (see details below regarding the use of a pen instead of a card); and a sensor disposed within the grip of the (stylus) (items 290 and 300, in Fig. 5), the sensor enabling the capture of a biometric property of a finger

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(See for example, col. 5, lines 20-24) (while the stylus is being used for writing upon the surface). While the above-identified elements and sections are directed to an authenticator card 120, this card can be modified into a pen device having the same functionality (See for example, Figure 8). At col. 5, lines 53-67, Karamchetty clearly states: "FIG. 8 shows the card device modified into a pen device 460, which is used in combination with a signature pad 470. The pen device has two capacitance grids on the surface 500 of the pen, at locations where the user's thumb 480 and the index finger 490 will be holding the pen. In this arrangement, we accomplished several things. As the user holds the pen in a natural writing position, the two-capacitance grids make contact with the thumb and the index finger and take the fingerprint impressions. Additionally, as the user signs, a signature impression is also taken. The signature impression can be based on accelerometers. Now, the card contains the user's signature, in addition to two of his/her fingerprint identification signals. This allows for greater security and actual notation that the user actually signed some part of a document." Additionally, at col. 7, lines 33-48, Karamchetty further states: "instead of using a card, a user may wish to use a pen with the same functionality. In the case of a pen, the capacitance grids are placed on the sides of the pen where it is gripped. The capacitance grids are located so that a user places the thumb and the index finger on the sensing surfaces. This geometric arrangement serves the same purpose as the card with sensing surfaces on both sides. However, the pen device can be used to store a user's signature signal also. The user makes a signature mark on a pad. The motion of the pen during signature is captured as a signal and stored in the electronic circuitry in the pen itself. When the user wishes to enter a system, he/she uses the pen device. The fingerprint devices identify the user to the system and provide access to the system. The signature portion of the

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device allows the system to certify that the user actually signed a specific electronic document.”

Thus, Karamchetty anticipates each of the features recited in claim 1.

With regard to claim 2, the identity authentication device of claim 1, wherein the biometric property is a fingerprint (See for example, col. 5, lines 58-61).

With regard to claim 3, the identity authentication device of claim 1, wherein the device is wireless and portable (See for example, Fig. 10)

With regard to claim 4, the identity authentication device of claim 1, wherein the surface is a digital surface, i.e., signature pad, and there is a tethered connection of the device to the area proximate to the digital surface (See for example, Fig. 9).

With regard to claim 5, the identity authentication device of claim 1, wherein the capture component is a scanner (which broadly reads on “reader”) (See for example items 290 & 300, in Fig. 5).

With regard to claim 6, the identity authentication device of claim 1, wherein text written on the surface and text written on the surface are captured for processing (See for example, col. 5, lines 61-62).

With regard to claim 7, claim 1 encompasses the limitation of this claim. Thus, argument analogous to that presented above for claim 1 is equally applicable to claim 7. Claim 7 distinguishes from claim 1 only in that it recites the stylus being used to capture text written by the stylus upon a surface, the stylus including a component to capture text generated by the

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stylus, the identity authenticator device limiting access to text written by the stylus to a person who generates the text (col. 5, lines 53-67; and col. 7, lines 33-48).

With regard to claim 8, the identity authenticator of claim 7, wherein the authenticator is a fingerprint sensor (See for example, Fig. 5).

With regard to claim 9, the identity authentication of claim 7, wherein the stylus is wireless and portable (See for example, Figure 10)

With regard to claim 10, the identity authentication of claim 7, wherein the surface is a digital surface, i.e., signature pad, and there is a tethered connection of the device to the area proximate to the digital surface (See for example, Fig. 9).

With regard to claim 11, the identity authentication of claim 7, wherein the component is a scanner (which broadly reads on "reader") (See for example, items 290 & 300, in Fig. 5).

With regard to claim 12, the identity authentication of claim 7, wherein text written on the surface and text written on the surface are captured for processing (See for example, col. 5, lines 61-62).

With regard to claim 13, a signature pad (item 470, in Fig. 8) the electronic signature comprising a stylus, i.e., pen (item 460, in Fig. 8) the stylus having a grip, a device being disposed in the stylus grip that authenticates identity of a person generating the electronic signature (See for example, items 480 and 490, in Fig. 8) identity authentication being performed in an incidental manner while the stylus is being used (See for example, col. 5, lines 53-67).

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Claims 14, 15, 16, 17, and 18 are rejected the same as claims 8, 9, 10, 11, and 12 respectively. Thus, argument analogous to those presented above for claims 8, 9, 10, 11, and 12 are equally applicable to claims 14, 15, 16, 17, and 18.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Numbers: 5103486, 5247137, 5774571, 5838306, 5859420, and 5991431; and a Publication to Rogers "Biometrics" (See page 4, column 3).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL G MARIAM whose telephone number is 703-305-4010. The examiner can normally be reached on M-F (7:00-4:30) FIRST FRIDAY OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LEO BOUDREAU can be reached on 703-305-4607. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DANIEL MARIAM
PRIMARY EXAMINER

May 10, 2004